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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,505	10/16/2003	Christine Noel	231893US0	5083

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EXAMINER	
GOLLAMUDI, SHARMILA S	

ART UNIT	PAPER NUMBER
1616	

DATE MAILED: 07/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/685,505	NOEL ET AL.	
	Examiner	Art Unit	
	Sharmila S. Gollamudi	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 May 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) *2,3 and 21-24* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 4-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I, claims 1-20, in the reply filed on 12/27/05 is acknowledged. The traversal is on the ground(s) that the search for one group would necessarily overlap in the search for another group and its subclasses. This is not found persuasive for the following reasons: firstly the examiner points out that searching similar classification does not necessarily provided for an overlapping search and it is not the only criteria to fulfill the burdensome search requirement. However, as set forth in the elections restriction requirement, Groups I and III have different classification. Secondly, as set forth in the Election Requirement, the Groups independent or distinct since invention I can be used for several different methodologies such as for makeup for the lips and skin; for treating and protecting the skin; and for cleansing the skin or hair, treat various inflammatory skin disorders, and for bleaching the hair and invention II can be used with different products other than invention I. Invention II is directed to the process of using the composition of invention I to stabilize an oil-in-water emulsion; however a method of stabilizing a emulsion may be practiced with a materially different composition such as an emulsifying systems, which are routinely used in the art to stabilize emulsions. With regard to rejoinder, the examiner points out that the examiner stated clearly in the Election Restriction Requirement that the applicant is entitled to rejoinder of Group I and II if Group I was found to be allowable.

With regard to the species requirement, the examiner notes the election of lipophilic amino acid, claims 1, 4-23. The species have different functions and effects. For instance, species I, lipophilic salicylic acid compounds, treat inflammatory diseases whereas species II,

lipophilic amino acid compounds, are utilized as antioxidants. Thus, the species are considered to be patentably.

Claims 1 and 4-20 are being prosecuted and claims 2-3 and 21-24 are withdrawn as being directed to a non-elected specie and invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 6-18, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 02/03952.

WO '952 teaches skin care composition comprising silicone elastomers and a skin care active. See abstract. The composition may be in an oil-in-water emulsion. See page 32, lines 15-20 and examples. The composition comprises silicone elastomers in an amount of 1-20%. The organopolysiloxane is preferably an addition reaction curing organopolysiloxane in the presence of a platinum catalyst. The instant organopolysiloxane is taught. See pages 10-14. The carrier for the elastomer serves to suspend and swell the elastomer particles to provide elastic, gel-like matrix. The carrier is utilized in an amount of 5-50% and may be volatile or non-volatile oil. See page 14. The composition further comprises thickening agents including carboxylic acid polymers, polyacrylate polymers, polysaccharides, gums, and instant polyacrylamide polymer (Speigel) in the amount of 0.1-5%. See page 19-22 and particularly page 20, line 30 to page 21, line 7. WO '952 teaches the use of active agents including anti-wrinkles agents such as N-acetyl-

derivatives, for instance N-acetyl-cysteine (see page 46, line 24) and antioxidants such as methionine, proline, or lysine in an amount of 0.1-10% to provide UV protection (see page 48, line 20). The composition may be formulated into facial skin cosmetics, eye cosmetics, anti-wrinkle creams, lip cosmetics, foundations, etc. The composition is useful in reducing the appearance of wrinkles, scars, skin roughness, blemishes, pores, etc.

Although WO '952 teaches the use of lipophilic amino acids such as N-acetyl-cysteine and methionine, the active agents taught by WO '952 are not sufficiently limited for one to immediately envisage the use of the N-acetyl-cysteine, proline, or methionine; thus the rejection is made under obviousness.

It would have been obvious for one of ordinary skill in the art at the time the invention was made to look to the guidance provided by WO '952 and utilize N-acetyl-cysteine or methionine in the composition to provide an o/w emulsion comprising 1) silicone elastomers; 2) a hydrophilic polymer; and 3) a lipophilic amino acid. One would have been motivated to do so since WO '952 teaches the use of N-acetyl-cysteine if one desired to formulate an anti-wrinkle cream and methionine if one desired to formulate a UV protection cream. Therefore, the selection of the active agent is prima facie obvious depending on the desired aesthetic benefit provided by the skin care composition.

Note that claims 7 and 9, have product-by-process limitations and "even though product by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production, if the product in the product-by-process claim is the same or obvious from a product

of the prior art, the claim is unpatentable even though the prior art was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.Cir. 1985).

Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 02/03952 in further view FR 2771632 to Stoltz or US 20010002257 (English equivalent).

The teachings of WO '952 have been set forth above. In particular, WO '952 teaches the use of active agents including anti-wrinkles agents such as N-acetyl-derivatives, for instance N-acetyl-cysteine (see page 46, line 24), acne actives, and skin soothing agents.

The reference does not teach the instant lipoamino acid.

Stoltz teaches the use of N-acyl amino acids for formulating cosmetic compositions that provides soothing/protecting properties, retards skin aging, and provides disinfecting properties to treat acne. The amino acids taught are undecylenoyl glycine and octanoyl glycine. See abstract.

It would have been obvious for one of ordinary skill in the art at the time the invention was made to combine the teaching of WO '952 and Stoltz and utilize the instantly claimed amino acid. One would have been motivated to do so since Stoltz teaches the undecylenoyl glycine and octanoyl glycine provides soothing/protecting properties, retards skin aging, provides disinfecting properties to treat acne and WO'952 teaches anti-wrinkles agents such as amino acid derivatives, the use of antioxidants such as methionine, acne actives, and soothing/skin healing actives. Thus, a skilled artisan would have been motivated to utilize the instant amino acid to provide a cosmetic composition that provides all three skin benefits of treating acne, retarding aging, and soothing the skin in a single formulation. A skilled artisan would have expected success since Stoltz teaches the use of various skin active agents including lipoamino acids.

Claims 1 and 4-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1055406 or US 6,296,859, the English equivalent in view of Fotinos (6,346,255).

Lorant teaches an oil-in-water emulsion comprising an organopolysiloxane elastomer in the oily phase and a water-soluble polymer in the aqueous phase. The oil-in-water emulsions are stable and thus do not contain a conventionally used surfactant. Lorant teaches emulsifiers are potentially irritating the skin, eyes and scalp and thus it is advantageous to formulate an emulsion without using emulsifiers to stabilize the emulsion. The compositions provide fresh and comfortable during application to the skin, unlike conventional compositions. See abstract and column 1, lines 18-36. Lorant teaches the use of α, ω dimethylvinylpolydimethylsiloxane. See column 4, line 50 and the elastomer gel is utilized in an amount of 0.03-40% and preferably 1.5-20%. See column 5, lines 59-66. The water-soluble polymers that are suitable include carboxyvinyl polymers; acrylic or methacrylic copolymers; natural gums; polysaccharides; acrylamide polymers and copolymers; vinyl ether copolymers; or cationic polymers, such as polyquaternium. Preferable acrylamide copolymers include the crosslinked copolymer of acrylamide and of 2-acrylamido-2-methylpropanesulphonic acid, in particular the mixture sold under the name Sepigel 305. The polymer is utilized in the an amount from 0.1 to 10%, preferably 0.2 to 5%, and more preferably from 0.5 to 2%. See column 6, line 5 to column 9, line 40. The oils utilized in the oil phase include non-volatile and volatile oils and the oily phase can range from 1 to 50%. See column 9, line 40 to column 10, line 25. The composition comprises active agent in the amount of 0.01-30% and may be antioxidants, lipophilic active agents, etc. Preferably the active agents include moisturizing agents; keratolytic agents; salicylic acid and its derivatives; vitamins; depigmenting agents; slimming agents; screening agents; and any active

principle appropriate for the final purpose of the composition. see column 10, lines 32-60. The composition suitable for treating dry skin and/or dry lips. See column 11, lines 1-7.

Lorant does not teach the use of the instant lipophilic amino acids.

Fotinos teaches improving skin appearance with akin permeation enhancer and a active agent. See abstract. Fotinos teaches the use of various lipoamino acids such as acylation products, which are anti-elastase and anti-collagenase agents (anti-wrinkle agents); the use of lipoamino acids such as lysine and lauroylmethionine as antioxidants; lipoamino acids such as instant capryloyl glycine as seboregulators; lipoamino acids such as lysine PCA and related compound as hydratives. See column 7, lines 36-65.

It would have been obvious for one of ordinary skill in the art at the time the invention was made to combine the teaching of Lorant and Fotinos and utilize lipoamino acids as the active agent in Lorant's composition. One would have been motivated to do so since Fotinos teaches lipoamino acids a large number of applications in the cosmetic field including anti-wrinkle agents, antioxidants, hydrating agents, and seboregulators and Lorant teaches the use of any skin active agent including antioxidants and moisturizing agents, depending on the final purpose of the composition. Therefore, the selection of the active agent is prima facie obvious depending on the desired aesthetic benefit provided by the skin care composition. Furthermore, a skilled artisan would have been motivated to utilize capryloyl glycine in particular if one desired to provide a composition that controls sebum, which causes acne.

Conclusion

Claims 1 and 4-23 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is 571-272-0614. The examiner can normally be reached on M-F (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Sharmila S. Gollamudi
Examiner
Art Unit 1616